Supreme Court, U. S.
FILED
MAY 17 1979
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

October Term, 1978

No. 78-1734

SOLOMON W. GOLOMB,

Petitioner,

vs.

WILLIAM KENT WADSWORTH,

Respondent.

PETITION FOR WRIT OF CERTIORARI.

ROBERT D. HORNBAKER,
A Member of
FREILICH, HORNBAKER, WASSERMAN,
ROSEN & FERNANDEZ,
A Professional Corporation,
10960 Wilshire Boulevard, Suite 1434,
Los Angeles, Calif. 90024,
(213) 477-0578; 477-4039,
Attorneys for Petitioner.

Parker & Son, Inc., Law Printers, Los Angeles. Phone 724-6622

SUBJECT INDEX

I. Page

Reference to Reports of Opinions Delivered in the Courts Below 1

II.

Concise Statement of the Grounds on Which the Jurisdiction of This Court Is Invoked 1

III.

Questions Presented for Review 2

IV.

Constitutional Provisions, Statutes and Regulations Which the Case Involves 2

V.

Statement of the Case 3

VI.

Argument 8

VII.

Conclusions 10

Appendix A. Opinion, Dated March 21, 1978 ..... App. p. 1

Appendix B. Opinion, Dated March 8, 1979 22

Appendix C. Order, Dated April 19, 1979 28

TABLE OF AUTHORITIES CITED

Cases	Page
Consolidated Foods v. Ferro, 189 USPQ 582 (TT& AB 1976)	8
Greene v. McElroy, 360 U.S. 474 (1958)	9
Old Monk Olive Oil Company v. Southwestern Coca-Cola Bottling Co., 118 F.2d 1015, 49 USPQ 192 (CCPA 1941)	5, 6
Rules	
Rules of Practice in Trademark Cases, Rule 112 (37 CFR §2.112)	3, 4, 9
Rules of Practice in Trademark Cases, Rule 116 (37 CFR §2.116)	2, 8
Rules of Practice in Trademark Cases, Rule 116(e) (37 CFR §2.116(e))	7
Rules of Practice in Trademark Cases, Rule 122(c) (37 CFR §2.122(c))	6
Statutes	
Trademark Act of 1946, Sec. 2(e) (15 USC §1052 (e))	4
Trademark Act of 1946, Sec. 14 (15 USC §1064)	2, 3, 4, 9
Trademark Act of 1946, Sec. 21(a) (15 USC §1071(a))	4
United States Code, Title 28, Sec. 1256	2
United States Constitution, Fifth Amendment	2, 8, 9, 10

Textbooks	Page
BNA's Patent, Trademark & Copyright Journal, No. 423, dated April 5, 1979, pp. A-6, A-7	8
10 Intellectual Property Law Review (1978), pp. xci-xciii	8
1 McCarthy, Trademarks and Unfair Competition, Secs. 20.28 and 20.29	7
8 Wright and Miller, Federal Practice and Procedure, Sec. 2107, p. 390	8
8 Wright and Miller, Federal Practice and Procedure, Sec. 2112, p. 403	8

IN THE

Supreme Court of the United States

October Term, 1978
No. .....

SOLOMON W. GOLOMB,

Petitioner,

vs.

WILLIAM KENT WADSWORTH,

Respondent.

PETITION FOR WRIT OF CERTIORARI.

I.
Reference to Reports of Opinions Delivered in the Courts Below.

The Trademark Trial and Appeal Board, hereafter called the Board, rendered an unreported opinion, dated March 21, 1978, attached as Appendix A.

The Court of Customs and Patent Appeals, hereafter called the CCPA, affirmed the Board, in an unreported opinion, dated March 8, 1979, attached as Appendix B.

II.
Concise Statement of the Grounds on Which the Jurisdiction of This Court Is Invoked.

Dr. Golomb seeks a review of the judgment of the CCPA, dated and entered on March 8, 1979.

The CCPA denied Dr. Golomb's petition for a rehearing, in an Order, dated April 19, 1979, attached as Appendix C.

This Court has jurisdiction to review the judgment, by writ of certiorari, under Section 1256 of Title 28, United States Code.

III.
Questions Presented for Review.

1. Is a party required to appear pursuant to a notice of taking his trial deposition, in a proceeding before the Board, and is his refusal to appear pursuant to a notice a denial of procedural due process under the Fifth Amendment of the United States Constitution?

2. Does a cancellation petitioner have standing, in a proceeding before the Board, if he fails to allege, and prove, facts showing how he is, or will be, damaged by the registration sought to be cancelled?

IV.
Constitutional Provisions, Statutes and Regulations Which the Case Involves.

The Fifth Amendment states that:

> "No person shall be . . . deprived of life, liberty, or property, without due process of law; . . ."

Rule 116 of the Rules of Practice in Trademark Cases, 37 CFR §2.116, provides that:

> "(a) Except as otherwise provided and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure."

Section 14 of the Trademark Act of 1946, also called the Lanham Act, 15 USC §1064, provides that:

> "A verified petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed by any person who believes that he is or will be damaged by the registration of a mark on the principal register established by this Act, . . ."

Rule 112 of the Rules of Practice in Trademark Cases, 37 CFR §2.112, states that:

> "The petition to cancel, . . . , must set forth a short and plain statement showing how the petitioner is or will be damaged by the registration, . . ."

V.
Statement of the Case.

Dr. Golomb filed an opposition, on July 25, 1975, to Wadsworth's application, filed November 16, 1974, to register "Pentomino Challenge," for "equipment including a board having at least one playing area marked with ninety (90) squares and at least one set of eighteen (18) one-sided pentominoes for playing games and solving puzzles," with the word "Pentomino" disclaimed apart from the mark as shown. Tr. 4-5, 47-51.*

Dr. Golomb's opposition was based, in part, on his registration No. 1,008,964, issued April 15, 1975, for "Pentominoes," for "equipment, consisting of the twelve distinct five-celled square figures and a playing board, for use in various combinational puzzles and in competitive board games." Tr. 47-50.

Wadsworth filed an Answer on or about October 20, 1975. Tr. 52-54.

Paragraph 10 of the Answer requested affirmative relief by way of cancellation of Dr. Golomb's registration. Tr. 53-54.

---

*Transcript of Record, pages 4-5, and 47-51.

In that Paragraph, Wadsworth alleged only that "Pentominoes" is descriptive, and that Section 2(e) of the Trademark Act, 15 USC §1052(e), bars registration of a mark which "when applied to the goods of applicant is merely descriptive . . . of them, . . ."

Wadsworth did not allege that he believed he was, or would be, damaged by the registration, as required by Section 14 of the Act, 15 USC §1064, nor did he set forth a short and plain statement showing how he was, or would be damaged, as required by Rule 112 of the Rules of Practice in Trademark Cases, 37 CFR §2.112.

Dr. Golomb filed a Reply to Request for Affirmative Relief by Way of Cancellation, on October 30, 1975, in which he denied each and every allegation in Paragraph 10, and alleged it failed to state a claim upon which relief could be granted. Tr. 55.

In the unreported opinion, dated March 21, 1978, attached as Appendix A, the Board dismissed Dr. Golomb's opposition, and granted the petition to cancel. Tr. 75-92.

Golomb filed a timely notice of appeal. Tr. 1-2.

In the unreported opinion, dated March 8, 1979, attached as Appendix B, the CCPA affirmed the Board.

The CCPA had jurisdiction under Section 21(a) of the Trademark Act of 1946, 15 USC §1071(a).

Wadsworth did not prove, or attempt to prove, any use of "Pentomino Challenge," at any time, and did not otherwise prove, or attempt to prove, any facts showing how he was, or would be, damaged by Dr. Golomb's registration.

Which raises this question: What facts did the CCPA rely upon to find Wadsworth had standing?

The record is bare, except for his application to register "Pentomino Challenge," filed November 16, 1974, almost a year before he filed his petition to cancel, on October 20, 1975.

In *Old Monk Olive Oil Company v. Southwestern Coca-Cola Bottling Co.*, 118 F.2d 1015, 49 USPQ 192 (CCPA 1941), the CCPA itself said this was not enough.

There, Old Monk filed, on June 10, 1938, a petition to cancel Coca-Cola's registration, issued April 22, 1924, for "Old Monk," for soft drinks. Old Monk had filed an application, on April 13, 1938, to register the same mark, for juices, and alleged use prior to Coca-Cola.

Like Wadsworth, however, Old Monk offered no evidence.

So the CCPA dismissed its petition.

Said the Court, at pages 196-197:

> "There is no evidence in the record showing use by appellant [Old Monk] of its mark at any time within five years immediately preceding the filing of its petition, unless petitioner's application for registration of its mark, filed April 13, 1938, is prima facie evidence of use of the mark by petitioner on or about that date, as contended for by appellant.
>
> * * *
>
> "Appellant has cited no cases supporting its contention, and we have found none. When the use of its mark by appellant at the time of filing

its petition was put in issue by appellee's answer, the burden was upon appellant to establish such use by competent proof. *To consider appellant's application for registration of April 13, 1938 as supplying such proof would deprive appellee of any opportunity to cross-examine appellant's representatives respecting the correctness of the recitals in said application. In our opinion said application stands in the same relation to this proceeding as would an ex parte affidavit* on behalf of appellant, which obviously could not be properly considered over the objection of appellee.*" (Italics added.)

Golomb, on the other hand, testified as follows:

"Q Have you been able to find a set of the puzzle or game sold under the name Pentomino Challenge?

"A No, I have never seen such a product. Since I first became aware of Mr. Wadsworth's application I have made serious efforts specifically to look for and to ask for such a game or puzzle in game stores, novelty stores, department stores and stationery stores. However, none of these stores that I have visited anywhere in my extensive travels have ever heard of such product. Moreover, I have never seen it advertised in either general or trade publications or elsewhere. Also my game agent, Dr. Atwater, who is an expert in the field of games and puzzles and very knowledgeable about the marketplace has never seen or heard of this product under the name Pentomino Challenge being offered for sale. The fact is that I have never seen or heard anything to indicate that Mr. Wadsworth has actually used this mark." Tr. 30-31.

*Wadsworth did not offer his application in evidence, or notice it under Rule 122(c) of the Rules of Practice in Trademark Cases, 37 CFR §2.122(c). So Dr. Golomb had no opportunity to object to it. Golomb's briefs, however, often objected to its consideration.

Significantly, Wadsworth did not object to this testimony, or move to strike it.

What's more, Wadsworth refused to appear pursuant to Golomb's notice of taking his trial deposition, on April 19, 1976, for examination on this issue.* Tr. 57-61, 70-74.

Instead, Wadsworth moved to vacate the notice, on the frivolous ground that the discovery period had closed on February 19, 1976. Tr. 58-59.

The Board granted Wadsworth's motion, and denied Golomb's motion for a default judgment, but on the ground, not urged by Wadsworth, that he had not been served with a subpoena. Tr. 70-74.

The Board also denied Golomb's motion for an extension of his testimony period, to serve Wadsworth with a subpoena. Tr. 61, 70-74.

*Rule 116(e) of the Rules of Practice in Trademark Cases, 37 CFR §2.116(e), provides that the taking of trial depositions corresponds to the trial in court proceedings. See also 1 McCarthy, *Trademarks and Unfair Competition*, §§20.28 and 20.29.

VI.
Argument.

The specialized CCPA failed to recognize one of the most important issues in the case, an issue outside the scope of its specialty: the denial of procedural due process under the Fifth Amendment.*

Dr. Golomb noticed Wadsworth for a trial deposition, on April 19, 1976. Tr. 57-61, 70-74.

Wadsworth refused to appear.

In granting Wadsworth's motion to vacate, and denying Golomb's motion for default judgment, and extension of time to serve a subpoena, the Board relied on its own isolated decision, in *Consolidated Foods v. Ferro*, 189 USPQ 582 (TT&AB 1976), published after the date set for Wadsworth's deposition, which did not mention Rule 116 of the Rules of Practice in Trademark Cases, 37 CFR §2.116, or the Federal Rules of Civil Procedure referred to therein.

However, the Federal Rules of Civil Procedure make it abundantly clear that a subpoena was not required.

For example, as stated in 8 Wright and Miller, *Federal Practice and Procedure*, §2107, at page 390, and §2112, at page 403:

> "Rule 37(d) provides sanctions for the failure of a *party*—or an officer, director, or managing agent of a party—to appear for the taking of his deposition after notice has been served upon him and the courts have reasoned that notice alone, *without subpoena*, is sufficient.
>
> * * *
>
> "If the person to be examined is a *party* to the action, *a subpoena is not required* and the notice is sufficient to require his attendance. Thus the examining party may set the place for the deposition of another party wherever he wishes subject to the power of the court to grant a protective order under Rule 26(c)(2) designating a different place." (Italics added.)

So Wadsworth's refusal to appear deprived Dr. Golomb of his Fifth Amendment right to confront and cross-examine him. *Greene v. McElroy*, 360 U.S. 474, 496 (1958).

Furthermore, because the Board, and the CCPA, did not require Wadsworth to plead, or prove, any facts showing how he was, or would be, damaged by Dr. Golomb's registration, as required by Section 14 of the Act, 15 USC §1064, and Rule 112 of the Rules of Practice in Trademark Cases, 37 CFR §2.112, they, in effect, required Dr. Golomb to assume the burden of proving the absence of such facts.

But he could not discharge this difficult burden, because Wadsworth refused to appear, although Dr. Golomb noticed his deposition under the applicable Federal Rules of Civil Procedure.

So the Board, and CCPA, deprived Dr. Golomb of his trademark registration by denying him the right to confront and cross-examine Wadsworth.

---

*This Court has recently reversed the CCPA in four cases in its specialty. See 10 *Intellectual Property Law Review* (1978), at pages xci to xciii. Nevertheless, Senator Kennedy introduced legislation to merge the CCPA and the Court of Claims, to form the U.S. Court of Appeals for the Federal Circuit, which would have exclusive jurisdiction over all issues in appeals from the District Courts in cases involving patent and trademark issues. See BNA's *Patent, Trademark & Copyright Journal*, No. 423, dated April 5, 1979, at pages A-6 and A-7.

VII.
Conclusions.

The Board, and the CCPA, have decided two important questions of federal law, which have not been, but should be, settled by this Court:

1. Is a party required to appear pursuant to a notice of taking his trial deposition, in a proceeding before the Board, and is his refusal to appear a denial of procedural due process under the Fifth Amendment?

2. Does a cancellation petitioner have standing, in a proceeding before the Board, if he fails to allege, and prove, facts showing how he is, or will be, damaged by the registration sought to be cancelled?

Also, in ignoring the statutes, regulations, and rules, the Board, and the CCPA, have so far departed from the accepted and usual course of judicial proceedings, as to call for an exercise of this Court's power of supervision.

Respectfully submitted,

ROBERT D. HORNBAKER,
A Member of
FREILICH, HORNBAKER, WASSERMAN,
ROSEN & FERNANDEZ,
A Professional Corporation,
Attorneys for Petitioner.

APPENDIX A.

Opinion.

Hearing: May 26, 1977.

U. S. Department of Commerce, Patent and Trademark Office.

Trademark Trial and Appeal Board.

Solomon W. Golomb v. William Kent Wadsworth. Opposition, No. 57,214, to application Serial No. 37,220, filed November 14, 1974.

Robert D. Hornbaker for Solomon W. Golomb.

George H. Mortimer for William Kent Wadsworth.

Before Rice, Fowler and Kera, Members, Members.

Opinion by Rice, Member:

An application has been filed by William Kent Wadsworth to register the mark "PENTOMINO CHALLENGE" for equipment including a board having at least one playing area marked with ninety (90) squares and at least one set of eighteen (18) one-sided pentominoes for playing games and solving puzzles, use since April 13, 1971 being asserted.[1] The word "PENTOMINO" has been disclaimed apart from the mark as shown.

Registration has been opposed essentially on the grounds that since November 1953, opposer has been using the mark "PENTOMINOES" for equipment consisting of twelve distinct five-celled square figures and a playing board, for use in various combinational puzzles and in competitive board games; that opposer is the owner of a registration of the mark "PENTO-

[1]Ser. No. 37,220, filed Nov. 15, 1974.

MINOES" for the aforesaid goods;[2] that opposer has expended substantial amounts of money, time and effort in advertising, promoting and popularizing his "PENTOMINOES" trademark, so that the trade in general and the purchasing public in particular have come to know and recognize opposer's trademark and products and to know that the same originate with and belong to opposer; that the word "PENTOMINO" is the dominant portion of applicant's mark "PENTOMINO CHALLENGE"; and that said mark so resembles opposer's mark "PENTOMINOES" as to be likely, when applied to the goods of the applicant, to cause confusion or mistake or to deceive.

Applicant, in answering the notice of opposition, has denied all of the allegations upon which opposer's claim of damage is predicated, asserting in connection therewith that neither word in applicant's mark is dominant in any physical sense; that the word "PENTOMINO" is used in applicant's mark as a descriptive word or adjective qualifying the noun or main word "CHALLENGE"; that if either word is dominant in a semantic sense it has to be the noun, not the adjective; and that applicant has disclaimed the word "PENTOMINO" apart from its mark as a whole, which disclaimer precludes a holding that said word is the dominant portion of applicant's mark. Additionally, applicant has filed a counterclaim to cancel opposer's pleaded registration on the grounds that the word "PENTOMINOES" is descriptive of polyominoes composed of five squares and thus of the twelve distinct five-celled square figures used by opposer in the equipment described in its pleaded registration; that the word

[2]Reg. No. 1,008,964, issued Apr. 15, 1974.

"PENTOMINOES" was first used in 1953 in a descriptive sense and not a trademark sense; that said word has continued to be used until today in the descriptive sense; and that:

> ". . . Opposer's rights, if any, in the word 'pentominoes' as a trademark have been abandoned through acts of commission and omission into the lexicon of the language generally employed by those engaged in the manufacture, marketing and playing of games employing playing pieces of five-clled square figures."

Opposer, in its answer to the counterclaim, has denied every allegation contained therein, and has affirmatively asserted both that applicant's counterclaim fails to state a claim upon which relief can be granted, and also that applicant is estopped to assert the allegations contained in the counterclaim.

The record consists of the pleadings; the file of applicant's application; the file of opposer's registration sought to be cancelled; copies of portions of printed publications made of record by applicant pursuant to Rule 2.122(c); and testimony in behalf of opposer. Both parties have filed briefs on the case and were represented at the oral hearing conducted on this matter.

The record shows that these parties were involved in a prior opposition[3] wherein applicant sought to register the mark "PENTOMINO CHALLENGE", without a disclaimer of the word "PENTOMINO", for goods described in essentially the same manner as those in applicant's present application; opposer based its opposition upon a claim of prior use of the mark "PENTO-

[3]Opposition No. 53,785; Golomb v. Wadsworth, 184 USPQ 249 (TT&A Bd., 1974).

MINOES" for game equipment and an allegation of likelihood of confusion; and applicant in turn raised the issue of whether opposer had used the term "PENTOMINOES" as a trademark or whether opposer possessed any proprietary rights therein as a trademark. The Board, in its opinion in that case, described the professional achievements of opposer, a Professor of Electrical Engineering and Mathematics at the University of Southern California, then summarized the remaining evidence made of record therein as follows:

> "Insofar as opposer's actviities pertaining to mathematical games and puzzles are concerned, on November 16, 1953, while a graduate student at Harvard University, opposer gave a lecture to the Harvard Mathematics Club based on research he had been doing during 1953 involving figures made of two, three or more square cells, entitled 'Combinatorial Geometry and Polyominoes'. In preparing his lecture, he became aware of a number of interesting and difficult puzzles involving five-celled square figures and coined the trademark 'PENTOMINOES' 'to try, or to identify, my own set of five-celled square figures, as distinct from anyone else's.' At the time of the lecture, he had only a demonstration set of the 'PENTOMINOES' game or puzzle available, but as a result of requests made by members of the audience, the following week he made fifty sets of five-celled figures out of poster board, and by the end of 1953, he had sold all of these sets for fifty cents each to members of the audience and their friends and others in the Harvard University. Each of the sets was contained in an envelope on which was typed 'PENTOMINOES' all in

capital letters, and underneath that 'Made by S. W. Golomb.' The game or puzzle consisted of twelve different shapes that can be made out of five equal squares or five-celled figures. Opposer prepared a number of different puzzles utilizing these pieces involving, inter alia, fitting them into rectangle or other shapes.

By the end of 1959, opposer had sold an additional two hundred sets all bearing the trademark 'PENTOMINOES' on the package containing the individual pieces. Opposer received some of the orders for the sets by mail after two articles appeared in the mathematical game section of the May and December 1957 issues of Scientific American magazine. He sold approximately twenty to thirty of these sets for seventy-five cents each to people who indicated by mail a desire to purchase them. Again, in the case of every set sold, the designation 'PENTOMINOES' appeared on the envelope or box in which the five-celled figures were placed.

Starting in or around 1955, opposer attempted to interest an established game company in manufacturing and selling the 'PENTOMINOES' game, but to no avail. In September 1962, he agreed with Collier Books to do a paperback book which would be called Polyominoes. The back cover of the book was to be stamped with the shapes of the five-celled square figures and would bear the mark 'PENTOMINOES'. It was to be prepunched so that the purchaser would have the ability to instantly have a set of these figures for use as he follows opposer's explanation in

the book. Collier Books, assertedly due to retrenchment plans, never did publish the book. It did, however, reach an agreement with Charles Scribner & (sic) Sons, publishers of New York, to have Scribner take over the project of publishing the book. Scribner did publish a book under the title Polyominoes; but because it was a hard cover book and did not lend itself to including a punched out removable game on the back of the book, an envelope was glued inside the back of the book which contained the twelve figures and which carried the trademark 'PENTOMINOES'. The Polyominoes book first appeared on the market in February 1965. More than ten thousand were sold, of which seven thousand were distributed through the Library of Science Book Club. Opposer received a royalty on each book. The book is still in print, and opposer is still receiving royalties which so far have amounted to several thousand dollars. Scribner has sublicensed several foreign publishers to do identical versions of the Polyominoes book with an identical enclosure of the puzzle identified by the designation 'PENTOMINOES'.

In early 1967, a Herbert Zimpfer of West Germany exhibited promotional sets of opposer's game with the mark 'PENTOMINO' (the two final letters 'E' and 'S' were omitted) at the Nurnberg Toy Fair and accepted orders. Zimpfer, under license from opposer, also sold games consisting of these twelve five-celled square figures under the trademark 'PENTOMINOES' in the United States during the period of 1967-1969. Opposer has received royalties on all sales by Zimpfer, and

they have been in excess of fifteen hundred dollars. However, because of tariff and customs difficulties as well as marketing problems, it was agreed that Zimpfer would confine his efforts to selling the game outside of the United States.

In November 1967, opposer recruited an agent to assist him in finding a game publisher to purchase (sic) and sell the 'PENTOMINOES' game. The agent put him in touch with Hallmark Cards, Incorporated of Kansas City, Kansas, which executed an agreement with opposer as a licensee to produce and sell the game. In May 1973. Hallmark exhibited at the Stationers Show in New York City a game under trademark 'PENTOMINOES' and accepted orders from wholesalers and distributors.

Opposer, over the years, developed a large quantity of exhibits and promotional material, and has traveled considerable distance to give lectures for no honorarium or fee to high schools and other groups, largely for promoting his 'PENTOMINOES' game.

Applicant's record consists of copies of articles by opposer and others that have appeared in such publications as The Scientific American Book of Mathematical Puzzles & Diversions, Recreational Mathematics Magazine, The American Mathematical Monthly and New Scientist over the years from 1954 through November 1962 and a copy of opposer's book Polyominoes published by Charles Scribner's Sons, noticed under Rule 2.122 (c) to '. . . show that the word 'pentominoes' from the date of its first use by Opposer and

others has been used in a descriptive sense and never in a trademark sense. . . .' "

Upon consideration of the documents made of record by applicant in the prior proceeding, the Board found that the terms "POLYOMINOES" and "PENTOMINOES", though they may have been coined by opposer, had been consistently used by opposer and others interested in mathematical puzzles in a merely descriptive sense to designate, respectively, various shapes composed of certain numbers of squares, and one particular kind of polyomino, namely, polyominoes of five squares; and that as a consequence, these terms, together with their singular forms, had become words of art in the field of mathematical puzzles and did not and could not serve to designate origin in anyone producing and selling a game which involved finding ways to fit together various shapes or configurations composed of numbers of connected squares. In support of this finding, the Board cited from the documents of record numerous representative examples of use of the term "PENTOMINO" by opposer and others in a descriptive manner, including examples from opposer's own book, *Polyominoes,* wherein the term "PENTOMINO" was defined as "A polyomino composed of 5 squares" and was consistently used by opposer in a descriptive if not generic manner.[4] The Board then held that

> ". . . whatever proprietary rights that opposer may have acquired in the term 'PENTOMINOES' or 'PENTOMINO' through the coining and first

[4]In connection therewith, the Board noted that while opposer had testified that the envelope (glued inside of the back of his book) which contained the twelve different five-celled square figures carried the trademark "PENTOMINOES", the envelope in the copy of opposer's book which was made of record in the opposition proceeding did not bear any trademark or other sign of origin.

> use thereof have since been abandoned through acts of omission and commission into the lexicon of the language generally employed by those manufacturing or participating in playing puzzles or games involving combinatorial geometry and, in particular, games of the type in which the parties here involved are interested in marketing."

The opposition was nevertheless sustained on the ground that the registration sought by applicant, *i.e.,* a registration of the mark "PENTOMINO CHALLENGE" without a disclaimer of the word "PENTOMINO", would be inconsistent with and in derogation of opposer's right to continue to use the term "PENTOMINO" in a descriptive manner in connection with the sale and advertising of his mathematical games. Applicant thereafter moved to disclaim the word "PENTOMINO" apart from its mark as a whole. The motion was denied, but without prejudice to applicant's right to file a new application to register "PENTOMINO CHALLENGE" with an appropriate disclaimer. Applicant's present application seeking registration of its mark with a disclaimer of "PENTOMINO" was filed two weeks thereafter.

In this proceeding, applicant's record again consists solely of copies of articles by opposer and others that appeared in the publications *Recreational Mathematics Magazine, Scientific American, The American Mathematical Monthly,* and *New Scientist* over the years from 1954 to 1962, as well as copies of portions of the book *The Scientific American Book of Mathematical Puzzles & Diversions* (Simon and Schuster, New York, 1959) and a complete copy of opposer's own book, *Polyominoes,* published by Charles Scribner's Sons in 1965.

Opposer has offered testimony in this proceeding to the same general effect as that adduced by him in the prior proceeding. In addition, opposer has testified that during the period 1967 to 1969, his West German licensee, Herbert Zimpfer sold the "PENTOMINO" game, as produced by Mr. Zimpfer, in the United States both by mail order and by sales through retail outlets; that since that time Mr. Zimpfer has continued to make mail order sales in the United States; that since 1967 opposer has always exhibited a sample of the aforesaid game produced by Mr. Zimpfer at all of opposer's talks; that opposer has received royalties from Mr. Zimpfer amounting to more than $4,000, of which approximately $1,000 was earned prior to April 1971 (the record does not indicate what portion of these royalties were from sales in the United States); that during 1973 and 1974 opposer's United States licensee, Hallmark Cards, Incorporated, sold approximately 20,000 of opposer's games, as produced by Hallmark, in boxes whose tops bear the word "PENTOMINOES" in relatively large letters, followed by "A NEW ADULT PUZZLE-GAME FROM SPRINGBOK" in smaller letters, then by the wording "A puzzle-game not for square thinkers! This mind bender will test the geometric perception of you and your friends. Object: arrange the puzzle pieces according to any one of a number of predetermined shapes," and, at the bottom, a copyright notice (1973) on behalf of Springbok Editions, a division of Hallmark Cards, Inc.; that the games are sold by Hallmark entirely through retail outlets such as toy stores, novelty stores, stationery and greeting card stores, department stores, etc.; that opposer has received in excess of $3,000 in royalties from Hallmark; that the last royalty check which opposer received prior to the taking of his deposition, which check covered the last quarter of calendar year 1975, was for the sale of several hundred sets of the game; that several other companies have sold games similar to opposer's game (i.e., games consisting of the same set of twelve five-celled square figures), but none of them have used the term "PENTOMINOES" in connection therewith; that opposer has made serious efforts to find applicant's game bearing the mark "PENTOMINO CHALLENGE" in game stores, novelty stores, department stores, and stationery shops, but has been unable to do so; that opposer's book *Polyominoes*, published in 1965, has been out of print for more than two years (as of the time of the taking of opposer's rebuttal testimony on August 13, 1976); that neither opposer nor the publisher of the book has any plans to reprint or reissue the book as previously published; that the "PENTOMINOES" games made by Hallmark were (in the opinion of opposer) purchased by a broad cross-section of the general lay public looking for games and toys of general interest, and having no specialized background; that the purchasers of opposer's book, and the readers of all of the other publications relied on by applicant, were (in the opinion of opposer) a limited set of devotees of formal recreational mathematics, typically with a professional background in mathematics, engineering, or the physical sciences; that *Recreational Mathematics Magazine* was privately published, had a very limited distribution (to enthusiasts of formal recreational mathematics), and has been defunct for more than ten years; that opposer visited nine major public libraries in Southern California looking for issues of said magazine, but was unable to find any; that the magazine *New*

Scientist is published in the United Kingdom; that opposer was unable to find any copies thereof in the nine libraries which he checked; that opposer drafted a letter dated April 23, 1975 indicating that "PENTOMINOES" is a registered trademark of opposer, that use thereof should always be accompanied by acknowledgement of this fact, and that unauthorized use constitutes infringement; that opposer mailed copies of this letter to the author or publisher, or both, of each of the documents relied on by applicant, as well as to other authors and publishers; that opposer has also been careful to point out at each of the six lectures he has given since April 15, 1975 (the date of the issuance of opposer's pleaded registration) that "PENTOMINOES" is a registered trademark for a game, and that the pieces of the game are called five-celled square figures; that he has never heard the term "PENTOMINOES" used in any manner other than as a trademark since April 15, 1975; and that in fact several authors have stated in their books and articles that "PENTOMINOES" is a registered trademark of opposer.

As noted above, the record in this case includes the file of opposer's pleaded registration, which is the subject matter of applicant's counterclaim for cancellation. An examination of this file reveals that the application which matured into said registration was filed on September 13, 1972; that the allegation contained a claim of distinctiveness made pursuant to the provisions of Section 2(f) of the Act, i.e., an assertion that the mark had become distinctive of applicant's goods as a result of substantially exclusive and continuous use in interstate commerce for the five years next preceding the date of filing of the

application (this claim, of course, constitutes an admission that the term "PENTOMINOES" was at least at one time merely descriptive as applied to opposer's goods); that opposer indicated in the application that his mark was used by applying it to containers for his goods and to instructional material associated with the goods; that the specimens of record consist of reproductive copies of a portion of the cover of opposer's book, *Polyominoes,* namely, the front of the cover and the upper part of the front cover flap; that the front of the cover contains the word "POLYOMINOES" in large letters, the phrases "The Fascinating New Recreation in Mathematics" and "BY SOLOMON W. GOLOMB" in smaller letters immediately thereunder, a representation of the twelve five-celled square figures, and then the phrase "Including more than 190 diagrams and a set of pentominoes;" that the upper part of the front flap of the cover contained the word "POLYOMINOES" in large letters with the phrases "by Solomon W. Golomb" and "INCLUDING MORE THAN 190 DIAGRAMS AND A SET OF PENTOMINOES" in smaller letters thereunder; that the lower section of the front flap is missing, having apparently been cut out or covered up by opposer prior to the making of the reproduced copies thereof (the copy of opposer's book which was made of record by applicant herein indicates that the missing lower portion of the front flap reads as follows:

> "This is the first book on the popular new mathematical recreation, polyominoes. It is written by the man who introduced it to American puzzle fans and invented many of the problems presented herein.

A *domino* is the simplest *polyomino*. Composed of only 2 squares, it has only one possible shape, a rectangle. A *tromino* is a polyomino of 3 squares; there are 2 possible tromino shapes. *Tetrominoes* are polyominoes of 4 squares and have 5 possible shapes; *pentominoes* are polyominoes of 5 squares and have 12 different shapes. All of these forms are dealt with by Dr. Golomb, as well as polyominoes composed of more squares and n-ominoes, that is, polyominoes of *any* specific number of squares. Diversions with polyominoes of more than 2 dimensions are also presented.

Puzzles in the volume range widely in difficulty; in some cases the pentominoes can be arranged in only one way, but one construction has 2,339 solutions. The Problem Compendium contains almost 100 problems, offering the reader weeks of diversion, and there are instructions for a pentomino game for 2 or more players.");

that the Examiner, in his first Office action, advised opposer that there was pending in the Office an application (i.e., the first application of applicant herein, that is, the application to register the mark "PENTOMINO CHALLENGE" without a disclaimer of the word "PENTOMINO") for the registration of a mark which so resembled opposer's mark as to be likely to cause confusion within the meaning of Section 2(d), and that applicant's said application, being the first filed, would, if and when it matured into registration, be cited as a reference against opposer's application; that on November 5, 1973 opposer filed a response stating that it had filed an opposition to applicant's application on November 30, 1972, and asking that action on its own application be suspended pending

the outcome of the opposition; that the response was accompanied by a copy of the notice of opposition, wherein opposer asserted prior rights in the term "PENTOMINO" as a trademark; that opposer did not file a copy of applicant's answer to the notice of opposition, wherein applicant placed in issue the question of whether opposer had used the term "PENTOMINOES" as a trademark and whether opposer possessed any proprietary rights therein; that the Examiner suspended action on opposer's application pending the outcome of the opposition proceeding; that on August 3, 1974, opposer filed a paper the complete text of which reads:

> "In your communication to me dated Feb. 21, 1974 (copy enclosed), you informed me that: 'Action on this application is suspended pending the termination of Opposition No. 53,785.' You further stated: 'When the proceeding is terminated, applicant, if a party thereto, should advise the examiner.' I was the Opposer in Opposition No. 53,785. In a decision dated August 8, 1974, the Trademark Trial and Appeal Board has ruled as follows on Opposition No. 53,785: 'Decision: The opposition is sustained, and registration to applicant is refused.' "

and that opposer's application was thereupon passed to publication and matured into registration.

Opposer contends that the issues presented in the cancellation proceeding are whether applicant was being damaged by opposer's registration of the term "PENTOMINOES" on or about October 20, 1975, the date of the filing of the counterclaim for cancellation, and whether the term "PENTOMINOES" was at that time merely descriptive to ultimate purchasers, that

is, without a distinctive secondary meaning; and that the sole issue in the opposition proceeding is likelihood of confusion. In connection therewith, opposer contends that the counterclaim for cancellation should be dismissed because applicant, who offered no evidence with respect to his activities under the mark "PENTOMINO CHALLENGE", neither alleged nor proved that he would be damaged by the continued existence of opposer's registration sought to be cancelled; i.e., applicant failed to establish his standing to be heard on the issues raised in the counterclaim. Under the particular circumstances presented in this case, we cannot agree with opposer's contention. That is to say, the Court of Customs and Patent Appeals has recently held that an argument asserting failure of an opposer to prove that it may be "damaged" is in actuality an allegation that opposer has not demonstrated its standing to oppose; and that a party has standing to oppose within the meaning of Section 13 if that party can demonstrate a *real interest* in the proceeding. See: Federated Foods, Inc. v. Fort Howard Paper Company, 192 USPQ 24 (CCPA, 1976). See also: Universal Oil Products Co. v. Rexall Drug and Chemical Co., 174 USPQ 458 (CCPA, 1972). Similarly, of course, a party has standing to maintain a petition for cancellation within the meaning of Section 14 of the Act (which provides that a petition to cancel a registration of a mark may be filed by "any person who believes that he is or will be damaged by the registration of a mark on the principal register") if that party can demonstrate a real interest in the proceeding. In the instant case, applicant's petition for cancellation is in the nature of a compulsory counterclaim filed in answer to the notice of opposition (it having been

the view of the Board for a number of years now that it is mandatory that a party assert as a counterclaim any claim which, at the time of the serving of his pleading, he has against the adverse party, provided that the counterclaim arises out of the transaction or occurrence which is the subject matter of the other party's claim—See: Delta Tire Corporation v. Sports Car Club of America, Incorporated, 185 USPQ 443 (TT&A Bd., 1975), and cases cited therein), and it is implicit from applicant's position or standing as defendant in this opposition, when considered together with the fact that applicant was involved with opposer in the above-described prior proceeding and thus manifestly is no mere stranger of interloper, that applicant has a real interest in the cancellation proceeding. Moreover, inasmuch as we have jurisdiction over opposer's registration by virtue of the filing of the counterclaim for cancellation, we have authority under Section 18 of the Act to cancel the registration if it was obtained fraudulently or is otherwise invalid. In this regard, opposer's registration is manifestly invalid since it was issued immediately after, and in the face of, the Board's ruling in the prior opposition that the word "PENTOMINOES" was a merely descriptive term which did not and could not serve to designate origin in anyone producing and selling a game that involved finding ways to fit together various shapes or configurations composed of numbers of connected squares, and that whatever proprietary rights opposer might have acquired in the term "PENTOMINOES" or "PENTOMINO" through the coining and first use thereof had since been abandoned through acts of omission and commission into the lexicon of the language generally employed by those manufacturing or participating in play-

ing puzzles or games involving combinatorial geometry and, in particular, games of the type marketed by opposer and applicant.[5]

Aside therefrom, the doctrine of res judicata provides that "a judgment on the merits in a prior suit involving the same parties or their privies bars a second suit based on the same cause of action." See: Lawlor v. National Screen Service Corporation, 349 U.S. 322, 75 S. Ct. 865 L.Ed. 1122 (1955). See also: Cromwell v. County of Sac, 94 U.S. 351 (1878), and Commissioner of Internal Revenue v. Sunnen, 77 USPQ 29 (Sup. Ct., 1948). However, as noted by the Board in Johnson & Johnson v. Rexall Drug Company, 186 USPQ 167 (TT&A BD., 1975), where a second suit on the same ground is based upon circumstances or a course of conduct occurring subsequent to the judgment in the prior suit, then the second suit constitutes a different cause of action and is not barred by the doctrine of res judicata. The reason for this rule, according to the Lawlor case, supra, is that "the prior judgment cannot be given the effect of extinguishing claims which did not even then exist and which could not possibly have been sued upon in the previous case."

[5]Applicant also asserts in its brief on the case that opposer's registration is invalid for the further reason that it was obtained fraudulently, i.e., that opposer withheld from the Examiner the information that the Board had found that opposer had no existing proprietary rights in the term "PENTOMINOES". However, this issue was neither pleaded nor tried, and opposer thus had no opportunity to defend himself against it. In view thereof, applicant's charge of fraud is untimely raised and cannot be considered in our determination of this case. See: Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc., 189 USPQ 138 (CCPA, 1976); Browning Debenture Holders Committee v. DASA Corp., 23 FR Serv2d 1298 (CA 2, 1977); Dap, Inc. v. Litton Industries, Inc., 185 USPQ 177 (TT&A Bd., 1975); and Taffy's of Cleveland, Inc. v. Taffy's, Inc., 189 USPQ 155 (TT&A Bd., 1975).

See also: Commissioner of Internal Revenue v. Sunnen, supra, and United States v. General Electric Company, 358 F. Supp. 731 (DC NY, 1973). Cf., Old Grantian Company Limited v. William Grant & Sons Limited, 150 USPQ 58 (CCPA, 1966), and DeCosta v. Columbia Broadcasting System, Inc., 182 USPQ 169 (CCPA, 1974). Where the second action involves a different claim, cause, or demand, the judgment operates as a collateral estoppel as to "those matters in issue or points controverted, upon the determination of which the finding or verdict was rendered." See: Cromwell v. County of Sac, supra. In view of the foregoing, opposer is estopped, by the Board's decision in the prior opposition, from denying herein that as of August 8, 1974 (i.e., the date of said decision), the term "PENTOMINOES" was a merely descriptive term which did not and could not serve to designate origin in anyone proceduring games such as those here involved, and that any rights which opposer may have acquired in said term through the coining and first use thereof had been abandoned into the lexicon of the language generally employed by those manufacturing or participating in the playing of such games. Thus the only question to be determined in this proceeding, insofar as the issue of descriptiveness is concerned, is whether the term "PENTOMINOES" has, since August 8, 1974, become distinctive of opposer's goods in commerce. And inasmuch as the clear import of the Board's decision in the prior opposition was to the effect that the term "PENTOMINOES" was highly descriptive, if not generic, as applied to games such as opposer's, opposer's burden of proof to establish that it has "recaptured" said term as a trademark is very heavy. Cf., Donald F. Duncan, Inc. v. Royal Tops Manufactur-

ing Company, Inc., 144 USPQ 617 (CA 7, 1965). Considering the short period of time which has elapsed since the prior opposition (i.e., opposer's testimony as defendant in the counterclaim herein was taken on August 13, 1976, only two years after the date of the Board's decision in the previous proceeding), together with the factors that opposer's oral testimony is naturally self-serving in nature; is to a large extent devoted to an attempt to correct deficiencies in the testimony offered by opposer in the prior proceeding; and is supported by no documentary evidence other than material pertaining to opposer's professional achievements, a photograph of a box allegedly used by opposer in the sale of eighteen deluxe (i.e., wood) sets of his game in the late 1950's, the tops of the boxes used by opposer's West German and U. S. licensees in marketing the game, and a copy of the April 23, 1975 trademark infringement letter allegedly sent by opposer to a number of authors and publishers, the record presented herein falls far short of persuading us that the term "PENTOMINOES" has in fact become distinctive of opposer's goods in commerce. To the contrary, we believe that the weight of the evidence in this case supports applicant's assertion that such term is merely descriptive of opposer's games. In view thereof, and since applicant's present application to register its mark "PENTOMINO CHALLENGE" contains a disclaimer of the word "PENTOMINO" apart from the mark as shown, it is concluded that opposer would not be damaged by the registration sought

by applicant. Cf., C. R. Bard, Inc. v. Foley Bag Catheter, Inc., 157 USPQ 579 (CCPA, 1968).

Decision: The opposition is dimissed with prejudice; the counterclaim for cancellation is granted; and Registration No. 1,008,964 will be cancelled in due course.

/s/ J. E. Rice
J. E. Rice

/s/ C. R. Fowler
C. R. Fowler

/s/ D. J. Kera
D. J. Kera

Members, Trademark
Trial and Appeal Board

APPENDIX B.

Opinion.

United States Court of Customs and Patent Appeals.

Solomon W. Golomb, Appellant, v. William Kent Wadsworth, Appellee. Appeal No. 78-582. Opposition No. 57,214.

DECIDED: March 8, 1979

Before MARKEY, Chief Judge, RICH, BALDWIN, LANE, and MILLER, Associate Judges.

RICH, Judge.

This appeal is from the decision of the Patent and Trademark Office (PTO) Trademark Trial and Appeal Board (board) dismissing appellant's opposition to the registration of PENTOMINO CHALLENGE for game equipment[1] and granting appellee's counterclaim for cancellation of PENTOMINOES for game equipment.[2] We affirm.

The involved goods are essentially identical. A pentomino is a "polyomino," a term appellant Golomb fabricated from "domino" and defined as a simply-connected set of squares.[3] Whereas a domino has two squares and one configuration (a rectangle), a pentomino has

[1]Serial No. 37,220, filed November 15, 1974, the word PENTOMINO being disclaimed, use since April 13, 1971, being asserted.

[2]Registration No. 1,008,964, issued April 15, 1974.

[3]Appellant's brief argues that " 'Pentominoes' was * * * in particular * * * not derived from dominoes," which we find to be unsupportably at odds with his statement that he has "generalize[d] the 'domino' to the 'polyomino'." Golomb, "Checker Boards and Polyominoes," *American Mathematical Monthly* 675 (Dec. 1954).

five squares and twelve possible configurations. Appellant's game equipment consists of twelve pentomino playing pieces (one of each possible shape) and a game board marked with a playing area of sixty-four squares. Appellee's goods consist of eighteen pentominoes and a board marked with ninety squares.

We assume familiarity with a prior opposition in which appellee sought to register PENTOMINO CHALLENGE without disclaimer of PENTOMINO.[4] Therein, appellant, who had filed an application for registration of PENTOMINOES for game equipment on September 13, 1972, alleged prior and continuous use of PENTOMINOES and likelihood of confusion as to origin of the products. Appellee questioned whether appellant had used PENTOMINOES as a trademark and had any proprietary rights in the word as a trademark. Apparently addressing itself to appellant's contention of prior use as a trademark, the board found:

> It is clear from these documents that while opposer may have coined the terms "POLYOMINOES" and "PENTOMINOES" for use in creating puzzles or problems in combinatorial geometry, the branch of mathematics dealing with ways to combine geometric figures, these terms have been consistently used by opposer and others interested in mathematical puzzles in a merely descriptive sense to designate, as in the case of "POLYOMINOES", various shapes composed of certain numbers of squares, and as to "PENTOMINOES", as one kind of polyomino, namely polyominoes of five squares. As a consequence,

[4]*Golomb v. Wadsworth*, 184 USPQ 249 (TTAB 1974) (Opposition No. 53,785, application serial No. 391,735, filed May 11, 1971).

> these terms and naturally the singular forms "POLYOMINO" and "PENTOMINO" have become words of art in the field of mathematical puzzles and *do not and cannot serve to designate origin in anyone* producing and selling a game which involves finding ways to fit together various shapes or configurations composed of numbers of connected squares. [Emphasis ours.]

Notwithstanding its finding that appellant had used PENTOMINOES merely descriptively, if not generically, the board sustained the prior opposition on the ground that registration of PENTOMINO CHALLENGE without disclaimer of PENTOMINO would be "inconsistent with and in derogation of opposer's right to continue such [descriptive] use as he has made of 'PENTOMINO'." After the board denied appellee' motion to disclaim PENTOMINO from his mark, he filed the present application on November 15, 1974, seeking registration with such disclaimer. In the meantime, appellant's trademark registration had issued on April 15, 1974, despite the finding of descriptiveness by the board.

In the instant opposition appellant has asserted his registration of the mark PENTOMINOES and prior use since 1953, and has again alleged that likelihood of confusion would result if appellee's mark were registered. Taking his cue from the board opinion in the prior proceeding, appellee counterclaimed for cancellation of appellant's registration on the ground that use of the word pentomino since 1953 has been descriptive and that appellant's rights in the word, if any, "have been abandoned * * * into the lexicon of the language."

Concerning the counterclaim to cancel his registration of PENTOMINOES, appellant urges that Wadsworth has failed to allege damage, or belief of damage, according to Section 14 of the Trademark Act of 1946, 15 USC 1064. We note that in his answer to appellant's notice of opposition, appellee has requested cancellation on the ground that PENTOMINOES has been descriptively used and abandoned into the lexicon of the game language, all without specific mention of damage. But nothing else is necessary, for, as this court said in *DeWalt, Inc. v. Magna Power Tool Corp.*, 48 CCPA 909, 918, 289 F.2d 656, 661, 129 USPQ 275, 280 (1961):

> This court, since the earliest days of its jurisdiction over Patent Office appeals, has adhered to the then already established principle that damage to an opposer or *injury to a petitioner for cancellation*—those being the terms of the old law now replaced in the Lanham Act by "damage" in either situation—will be *presumed by inferred* when the mark sought to be registered is descriptive of the goods and the opposer or petitioner is one who has a *sufficient interest* in using the descriptive term in its business. [Citations omitted. Emphasis ours.]

Cf. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976) (opposer satisfied standing requirement by establishing "real commercial interest in protecting its registered marks").

Concerning the descriptiveness issue in the instant proceeding, the board referred to its prior decision on that point and, after discussing res judicata and collateral estoppel, concluded that "opposer is [col-

laterally] estopped, by the Board's decision in the prior opposition, from denying herein that as of" the date of the prior decision PENTOMINOES was merely descriptive, leaving only the question whether since that date anything had occurred to change the situation. The board's final conclusion was that the word "pentominoes" had not become distinctive and that "the weight of the evidence in this case supports applicant's [appellee's] assertion that such term is merely descriptive of opposer's [appellant's] games."

Since we agree with the board's conclusion on the evidence in the case, it is not necessary to consider whether there was an estoppel. Our own examination of the evidence shows it to be fully supportive of the board's conclusion of descriptiveness. Specifically, the excerpts from appellant's articles and book referred to in the first board opinion show conclusively that he employed the word "pentominoes" descriptively for the five-celled pieces and for whatever puzzles they constitute or whatever games may be played with them.

Appellant argues, *inter alia,* that his book *Polyominoes* (1965) and articles in *Scientific American* magazine from 1957-1962[5] were directed to and read by "a limited set of devotees of formal recreational mathematics," and that beginning in May 1973 his pentomino game was sold by Hallmark Cards, Inc., allegedly under the trademark "PENTOMINOES," to 20,000 purchasers of "a broad cross-section of the general public." We find the evidence to be to the

[5]Gardner, "Mathematical Games," *Scientific American,* Vol. 196 at 150 (May 1957), Vol. 196 at 166 (June 1957), Vol. 197 at 126 (Dec. 1957), Vol. 198 at 92 (Jan. 1958), Vol. 203 at 186 (Nov. 1960), Vol. 230 at 160 (Dec. 1960), Vol. 204 at 166 (June 1961), Vol. 207 at 151 (Nov. 1962).

contrary. The back flap of appellant's book says that since 1954, polyominoes "have found an enthusiastic audience among avid puzzle fans, professional mathematicians, and housewives interested in design," while Golomb's preface to the book states that the reprinting of his material in the May 1957 Scientific American "brought polyominoes to the attention of a vast reading public." Hence, the name pentominoes reached the same purchasing public as the game sold by Hallmark. Moreover, although the alleged mark PENTOMINOES is carried on the Hallmark box top, the word "pentominoes" is nonetheless again used as a descriptive name in the accompanying booklet. Appellant's remaining contentions are similarly insufficient to persuade us that the counterclaim to cancel should be dismissed.

We otherwise agree with the board that "since applicant's prsent application to register its mark 'PENTOMINO CHALLENGE' contains a disclaimer of the word 'PENTOMINO' apart from the mark as shown, it is concluded that opposer would not be damaged by the registration sought by applicant. Cf., C. R. Bard, Inc. v. Foley Bag Catheter, Inc., 157 USPQ 579 (CCPA, 1968)."

The decision of the board dismissing appellant's opposition with prejudice and granting appellee's counterclaim for cancellation is *affirmed.*

AFFIRMED

APPENDIX C.

Order.

(Letterhead)

United States Court of Customs and Patent Appeals
717 Madison Place NW.
Washington, D.C. 20439.

George E. Hutchinson, Clerk.
Telephone: 347-1552 Area Code 202

April 19, 1979

Mr. Robert D. Hornbaker
Lindenberg, Freilich, Hornbaker,
Wasserman, Rosen and Fernandez
10960 Wilshire Blvd.
Suite 1434
Los Angeles, California 90024

RE: Golomb v. Wadsworth
Appeal No. 78-582

Dear Sir:

The court denied today the petition for rehearing in the above appeal. Judge Lane took no part in the consideration of or decision on the petition.

Very truly yours,
/s/ George E. Hutchinson

cc: Mr. George H. Mortimer